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## **FAX COVER SHEET**

**TO:** Robin Einman

**FROM::** Examiner Chang, Art Unit 1625

**RE:** SN 09/760,590 Attorney's Docket: HMR 2041US1 NP1

**MESSAGE:**office action 11/06/02 per your request

**TOTAL PAGE** (including cover page) 5

If transmission is incomplete please contact Examiner Chang at 703-308-4702.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,590	01/16/2001	Kurt M. Kessler	HMR 2041 US NP1	4289

5487 7590 11/06/2002

ROSS J. OEHLER  
AVENTIS PHARMACEUTICALS INC.  
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EXAMINER
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CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/760,590

Applicant(s)

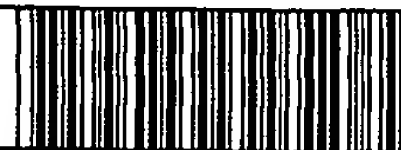
Kessler

Examiner

Celia Chang

Art Unit

1625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 30, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-19 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### DETAILED ACTION

1. Amendment and response filed by applicants in paper No. 9, dated July 30, 2002 have been entered and considered carefully. Claims 1-9 have been canceled. Claims 10-19 are pending.
2. The rejection of claims 1-9 under 35 USC 112 second paragraph and under 35 USC 103(a) over Kattige et al. '727 and Sedlacek are dropped in view of the amendments.
3. The rejection of claims 1-9 under 35 USC 103(a) over Kim '934 in view of Cheronis and Evans is now applicable to newly added claims 10-19 maintained for reason of record.

The gist of applicants argument is that the description of Kim '934 at col. 9, lines 53, is not convincing to applicants that this is a solvate. This is not persuasive. Please note that Kim et al. Gave explicit described that ".....the residue was stirred in MeOH (20 ml) at reflux.....and ethyl ether (50ml) was added.....precipitated solid was.....washed with ethyl ether three times and dried to afford a solid, 6.7 g which contained the title compound methanol". Please note that this explicit description provided evidence that a method was made under reflux and precipitated, washed to obtain such "compound methanol" which is consistent with the nomenclature of solvates/hydrates i.e. magnesium sulfate 7H<sub>2</sub>O or magnesium sulfate hydrate. As it has been provided by the state of the art reference Evans, that a clathrate which is crystalline organic material with small solvent being uncaged, is the mechanical embracing of organic material and solvents. Therefore, the explicit naming of the compound methanol product by Kim '934 is evidence that solvate/clathrate instead of compound per se was indicated by Kim.

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Please note that Kim '934 is a US patent. Explicit description and facts have been pointed out to applicants as to the nature of the product. Applicants' allegation that product of Kim '934 is not convincing to applicants being a solvate must be supported by preponderous of evidence since such allegation of inoperability of a US patent must be factual. Trans-World vs Al Nyman 219 USPQ 1059.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

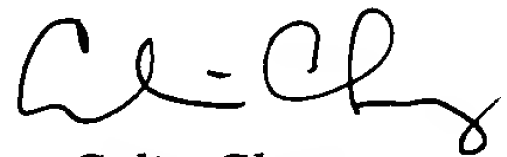
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 703-308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman, can be reached on (703) 308-4698. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7922.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

WP/Chang  
Nov. 4, 2002

  
Celia Chang  
Primary Examiner  
Art Unit 1625